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PATENT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant:	KOTZIN ET AL.)	
Appl. No.	10/628,200)	Examiner S. Chen
Confirm. No.	6111)	Art Unit 2821
Filed:	28 July 2003)	Atty. Docket No. CS10455
Title:	"Emergency Deployable GPS Antenna"		

PRE-APPEAL BRIEF REVIEW REQUEST

Assistant Commissioner for Patents
Alexandria, Virginia 22313

Sir:

Review Request & Claims Pending

The instant Request has been filed contemporaneously with a Notice of Appeal under 37 CFR 41.31 in response to the final Office Action mailed on 9 November 2005.

Entry of the amendment under 37 CFR 1.116 filed on 18 November 2005 is confirmed in the Advisory action of 29 November 2005.

Kindly review the instant application in view of the discussion below.

Claims 1, 3-17, 24-26, 31 and 32 have been allowed. Claim 30 stands objected to but was indicated as being allowable. Claims 27 and 29 stand rejected.

Claims 1-17, 24-27 and 29-32 are pending.

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Patentability of Claims Over Marino & Kang

Rejection Summary

Claim 27 stands rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 5,451,974 (Marino).

Claim 29 stands rejected under 35 USC 103(a) as being unpatentable over Marino in view of U.S. Patent No. 6,662,021 (Kang).

In the Advisory action mailed on 29 November 2005, the Examiner contends that

... the recitation that [sic] "a portable wireless communication device" [in the preamble] has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause.

Allowability of Claim 27

Regarding Claim 27, Marino does not disclose or suggest a

... portable wireless communication device, comprising:
at least one of a wireless receiver and wireless transmitter;
an antenna coupled to the at least one of the wireless receiver and wireless transmitter;
an antenna deployment system having a solenoid operatively coupled to antenna;
an antenna chamber, the antenna substantially contained within an antenna chamber,
the antenna movable between a docked position and a deployed position extending at least partially from the antenna chamber, the antenna movable to one of the docked position or the deployed position when the solenoid is energized.

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Discussion of Preamble

According to MPEP 2111.02, a preamble that merely recites the purpose of a process or use for an article is generally not given patentable weight. MPEP 2111.02, citing *In re Hirao*, 190 USPQ 15 (CCPA 1976) (Patentable weight not given to a recitation "...for preparing foods and drinks sweetened mildly..." in the preamble of a process claim.), and *Ex parte Wikdahl*, 10 USPQ2d 1546, 1548 (Bd. Pat. App. & Int. 1989) (Patentable weight not given to a recitation "...for separating material including fibers suspended in a liquid suspension into a light fraction containing the fibers and a heavy fraction containing rejects..." in the preamble of an apparatus claim.).

According to MPEP 2111.02, any phraseology in the preamble that limits the structure (as opposed to field of use or intended purpose) of the article or apparatus defines the scope of the claimed subject matter and must be given patentable weight. MPEP 2111.02 cites: *In re Stencil*, 4 USPQ 2d 1071, 1073 (Fed. Cir. 1987). Under these circumstances, according to MPEP 2111.02, the preamble may be relied upon to distinguish the claim from the prior art and to avoid infringement. MPEP 2111.02, citing *In re Stencil*, *Corning Glass Works V. Sumitomo Electric*, 9 USPQ2d 1962 (Fed. Cir. 1989), *Perkin-Elmer Corp. v. Computervision Corp.*, 221 USPQ 669, 675 (Fed. Cir.) cert. denied, 225 USPQ 792 (1984).

In *Corning Glass Works*, the Court of Appeals for the Federal Circuit held that a claim reciting an "optical waveguide" in the preamble ("An optical waveguide comprising") was not anticipated by a prior art reference that disclosed the limitations recited in the claim body (limitations drawn to a prior art composition) by giving patentable weight to the "optical waveguide" term in the preamble. In *Corning Glass Works*, the Court reasoned that the

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structure of the "optical waveguide" was inherent in the claim and concluded that the "optical waveguide" in the preamble was not merely a stated purpose or an intended use for the claimed structure, but gave life and meaning and provided further positive limitations to the invention claimed. MPEP 2111.02.

Like *Corning*, the "portable wireless communication device" limitation in the preamble of Claim 27 defines the claimed subject matter, and more particularly it provides context for the subject matter of the claim body. The "portable wireless communication device" limitation is not a field of use, since the subject of the claim body does not apply to fields or applications other than portable wireless communication devices. The preamble of Claim 27 must therefore be given patentable weight.

Discussion of Marino

Marino discloses a helical cell phone mounted on an automobile fender, Marino, col. 1: 35-48, not on a portable wireless communication device. The surface (17) in FIGs. 2-5 of Marino is an automobile fender, Marino, col. 2: 33-34, not a "chamber" as asserted by the Examiner. Thus contrary to the Examiner's assertion, Marino does not disclose or suggest an antenna in a "portable wireless communication device" having a "antenna chamber". Claim 27 is thus patentably distinguished over Marino.

Allowability of Claim 29

Regarding Claim 29, Marino does not disclose in combination with the limitations of amended Claim 27

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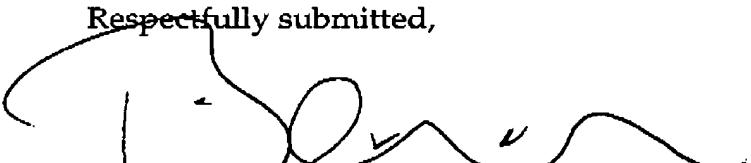
... the antenna chamber is disposed within a housing of the portable wireless communication device.

The Examiner's assertion that it would have been obvious to combine the automobile housing of Marino with the cell phone housing of Kang is misplaced. Further, assuming such a combination is made, it would not meet the limitations of Claim 29, which requires a chamber in combination with a wireless communication device housing. As noted above, Marino discloses an antenna mounted on an automotive fender. Claim 29 is thus further patentably distinguished over Marino and Kang.

Prayer for Relief

In view of the discussion above, the Claims of the present application are in condition for allowance. Kindly proceed with substantive examination of the instant application without further delay.

Respectfully submitted,


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